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10/529,584

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EXAMINER

GRANO, ERNESTO ARTURIO

ART UNIT

PAPER NUMBER

3728

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/529,584 | Applicant(s) PERSSON, CLAES | |
| | Examiner ERNESTO A. GRANO | Art Unit 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/27/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-16 and 20-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16 and 20-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/27/2009 has been entered.

- Claims 10 and 17-19 were canceled.
- Claims 22-24 were newly added.
- Claims 1-9, 11-16, and 20-24 are presented for examination.

Claim Rejections - 35 USC § 112

2. The previous 35 USC 112 rejection of claims 1-9 and 11-21 are withdrawn in light of Applicant's Amendment to the claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 8-9, 11, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) in view of Ueda et al. (US 4,632,250).

In re claim 1, Miller discloses a device **for storing and protecting** a card having an electronic data-carrying element from inadvertent erasure of data and/or other damage, comprising:

- a holder 10, **sized and shaped to** contain a card 15 comprising an electronic data-carrying element, the card 15 having a card width and a card length being longer than said card width, and the card being any one of a bank card, key card, membership card, cash card, and payment card (see Fig.1 of Miller)
- the holder 10 comprised of shielding metal sheets **configured to** envelop the data-carrying element of the card, the metal sheets of the holder being produced from one uniform piece of material as a sheet that is bent or folded at a fold such that the holder has the form of a first sheet portion 22, and a second parallel sheet portion 24 connected to the first sheet portion 22 via the fold, the second sheet portion 24 being connected to the first sheet portion 22 at a distance from the first sheet portion 22 **corresponding approximately** to a thickness of the card **to be** protected (see col.2, ll.1-14 of Miller)
- wherein a size of the first sheet portion closely corresponds to a size of the card such that an area of the first sheet portion 22 completely overlaps a whole surface area of the card 15 if placed on the surface,

wherein an area of the second sheet portion 24 is **configured to** completely overlap the data-carrying element of the card 15, upon the card 15 being fully inserted into the holder (see Fig.1 of Miller)

- wherein the area of the second sheet portion 24 is further **configured to** extend a distance from the fold such that a surface of the card 15, extending over the entire card length, is exposed and not overlapped by the second sheet portion 24 (see Fig.1 of Miller)

Miller discloses the claimed invention above, with the exception of the following claimed limitation that is taught by Ueda et al.:

- a soft ferromagnetic material having a high magnetic permeability, shielding metal sheets configured to envelop a data-carrying element of the card and protect, by electromagnetic shielding, the data-carrying element from erasure via exposure to any of magnetic and electromagnetic radiation emitted from a source external to the holder (see col.2, ll.52-67 of Ueda et al.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miller in view of Ueda et al. in order to protect the data-carrying element of the card from the adverse effects of external magnetic fields (see col.1, ll.6-8 of Ueda et al.)

Ueda et al. further discloses:

In re claims 8, 9, and 11: the shielding metal sheet thickness is larger than 0.05 mm (see col.2, ll.55-57 of Ueda et al.)

In re claim 21: the data-carrying element is capable of being any of a magnetic strip and a microchip (see col.1, ll.22-37 of Ueda et al.)

In re claim 22: the soft ferromagnetic material of said shielding metal sheets is configured to resist becoming magnetized as a permanent magnet, and the soft ferromagnetic material has a high saturation level such that the soft ferromagnetic material protects a card against powerful magnetic fields (see col.2, ll.15-68 of Ueda et al.).

In re claim 23: erasure of and electronic data-carrying element of said card if included is prevented by the soft ferromagnetic material of said shielding metal sheets upon exposure to magnetic energies of at least 70 mT (700 G) (see col.2, ll.30-37 of Ueda et al.).

In re claim 24: the shielding metal sheets are configured to protect, by electromagnetic shielding, the data-carrying element if included from erasure resulting from exposure to magnetic radiation emitted from the source external to the holder (see col.2, ll.15-68 of Ueda et al.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miller in view of Ueda et al. for the same reason as discussed in claim 1 above (see col.1, ll.6-8 of Ueda et al.).

Furthermore, It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

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5. Claims 6-7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) in view of Ueda et al. (US 4,632,250). Miller in view of Ueda et al. teach the claimed invention as discussed above, with the exception of the following claimed limitation:

In re claims 6-7 and 16: a metal shielding sheet made of a transformer sheet (e.g. "Electrical Steel").

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the metal sheets of Miller in view of Ueda et al. with transformer sheet (e.g. "Electrical Steel")., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) in view of Ueda et al. (US 4,632,250), and in further view of Wen Chi HU (FR 2,638,619). Miller in view of Ueda et al. teach the claimed invention as discussed in claim 1 above, with the exception of the following claimed limitations that are taught by Wen Chi HU:

In re claim 4: a holder is equipped with a suitable cleaning layer on the inner surface of at least one of its sheets (see abstract of Wen Chi HU)

In re claim 5: the cleaning layer is made of a suitable relatively soft rubber material, felt material or the like (see abstract of Wen Chi HU)

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miller in view of Ueda et al., and in further view of Wen Chi HU in order to prevent the card from getting damaged when being held (see abstract of Wen Chi HU).

7. Claims 2, 12, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) in view of Ueda et al. (US 4,632,250), and in further view of Littman (US Patent 3,027,995). Miller in view of Ueda et al. teach the claimed invention as discussed above, with the exception of the following claimed limitations that are taught by Littman:

In re claim 2: a layer or coating is applied to the external plane sides (see col.2, ll.4-6 of Littman).

In re claim 12: the coating is commonly known to be a wear-resistant material. (see col.2, ll.4-6 of Littman).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miller in view of Ueda et al., and in further view of Littman in order to enhance its appearance (see col.2, ll.4-6 of Littman).

Ueda et al. further discloses:

In re claim 20: the shielding metal sheet thickness is larger than 0.05 mm (see col.2, ll.55-57 of Ueda et al.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miller in view of Ueda et al. and in further view of Littman for the same reason as discussed in claim 1 above (see col.1, ll.6-8 of Ueda et al.).

Furthermore, It has been held that, where the only difference between the prior art and the claims is a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than a prior art device, the claimed device is not patentably distinct from the prior art device.

Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) in view of Ueda et al. (US 4,632,250), and in view of Littman (US Patent 3,027,995) and in further view of Parker (US Patent 4,792,058). Miller in view of Ueda et al. in view of Littman teach the claimed invention as discussed in claim 2 above, with the exception of the following claimed limitation that is taught by Parker:

In re claim 3: a layer is provided with distinctive marks in the form of a logo, advertising or other decoration (see col.5, ll.59-66 of Parker).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miller in view of Ueda et al. in view of Littman, and in further view of Parker in order to be used by corporations and/ or businesses as effective promotional sources or materials (see col.5, ll.59-66 of Parker).

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9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) in view of Ueda et al. (US 4,632,250), and in view of Littman (US Patent 3,027,995) and in further view of Kamens et al. (US Patent 5,941,375). Miller in view of Ueda et al. in view of Littman teach the claimed invention as discussed in claim 12 above, with the exception of the following claimed limitation that is taught by Kamens et al.:

In re claim 13: a coating is one of an elastomer and a suitable plastic material (see col.5, ll.4-8 and col.6, ll.37-52 of Kamens et al.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miller in view of Ueda et al. in view of Littman, and in further view of Kamens et al. in order to color coat the holder (see col.6, ll.37-52 of Kamens et al.).

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) in view of Ueda et al. (US 4,632,250), and in view of Littman (US Patent 3,027,995), and in further view of Wen Chi HU (FR 2,638,619). Miller in view of Ueda et al. in view of Littman teach the claimed invention as discussed in claim 12 above, with the exception of the following claimed limitations that are taught by Wen Chi HU:

In re claim 14: a holder is equipped with a suitable cleaning layer on the inner surface of at least one of its sheets (see abstract of Wen Chi HU)

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miller in view of Ueda et al. in view of Littman, and in further

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view of Wen Chi HU in order to prevent the card from getting damaged when being held (see abstract of Wen Chi HU).

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 5,524,750) in view of Ueda et al. (US 4,632,250), and in view of Littman (US Patent 3,027,995) in view of Parker (US Patent 4,792,058), and in further view of Wen Chi HU (FR 2,638,619). Miller in view of Ueda et al. in view of Littman in view of Parker teach the claimed invention as discussed in claim 3 above, with the exception of the following claimed limitation that is taught by Wen Chi HU:

In re claim 15: a holder is equipped with a suitable cleaning layer on the inner surface of at least one of its sheets (see abstract of Wen Chi HU)

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Miller in view of Ueda et al. in view of Littman, and in further view of Wen Chi HU in order to prevent the card from getting damaged when being held (see abstract of Wen Chi HU).

Response to Arguments

12. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Petsinger (US 6,121,544) and Godfrey (US 5,288,942) both disclose electric magnetic shielding sheets for a card holder.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERNESTO A. GRANO whose telephone number is 571-270-3927. The examiner can normally be reached on 7:00am - 5:00pm Mon.-Thur..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ehud Gartenberg can be reached on 571-272-4828. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ernesto A Grano/
Examiner
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EAG

/Ehud Gartenberg/

Supervisory Patent Examiner, Art Unit 3728